

## REMARKS

### A. 35 U.S.C. § 102

#### 1. Claims 1, 2, 4, 5, 7, 8

In the Office Action of April 14, 2005, claims 1, 2, 4, 5, 7 and 8 were rejected under 35 U.S.C. § 102(e) as being anticipated by Klein et al. Applicant traverses the rejection in that claim 1 recites a planar area that moves parallel to a first direction and below a web of a substrate, wherein “said web moves substantially independently of said planar area and said web lies upon said planar area” (emphasis added). The Office Action asserts that the web 38 lies upon a planar area as shown in Figs. 4A-D. However, Figs. 4A-D show that web 38 lies above and spaced from the conveyor belt 202. Such an orientation between the web 38 and the belt 202 cannot be considered to be that the web 216 is upon belt 202, since the word “upon” means “on” which in turn “is used as a function word to indicate position in or in contact with an outer surface” and so there must be some sort of contact between the web 38 and belt 202 for the web to be upon the belt.

Despite the impropriety of the rejection, claims 1, 2, 4, 5, 7 and 8 have been canceled in order to expedite prosecution of the application by having the allowed claims granted in a patent. Accordingly, the cancellation of claims 1, 2, 4, 5, 7 and 8 is not related to patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

#### 2. Claims 3 and 6

Claims 3 and 6 were rejected under 35 U.S.C. § 102(e) as being anticipated by Klein et al. Applicant traverses this rejection because claim 3 recites a web of a substrate that moves along a

first direction and a dispensing system that includes “a planar area that moves parallel to said first direction and below said web” (emphasis added). The Office Action asserts a planar area 202 moves parallel to the web 38 as shown in Figs. 4A-D. However, Figs. 4A-D shows that web 38 moves either at an angle relative to conveyor belt 202 or in a direction generally opposite to the conveyor belt 202. Since conveyor belt 202 does not move parallel to the direction of web 216, claim 3 is not anticipated by Klein et al. and so the rejection is improper. In addition, the web 38 is positioned above, not below, conveyor belt 202.

Despite the improperness of the rejection, claims 3 and 6 have been canceled in order to expedite prosecution of the application by having the allowed claims granted in a patent. Accordingly, the cancellation of claims 3 and 6 is not related to patentability as defined in *Festo*.

### **3. Claims 34, 35 and 37**

Claims 34, 35 and 37 were rejected under 35 U.S.C. § 102(e) as being anticipated by Klein et al. Applicant traverses this rejection since independent claims 34 and 35 each recites a process wherein a web of a substrate is moved along a first direction and a planar area is moved parallel to the first direction and below the web. The Office Action asserts a planar area 202 moves parallel to the web 38 as shown in Figs. 4A-D. However, as pointed out above in Section A.2 this is not the case. Accordingly, the rejection is improper.

Despite the improperness of the rejection, claims 34, 35 and 37 have been canceled in order to expedite prosecution of the application by having the allowed claims granted in a patent. Accordingly, the cancellation of claims 34, 35 and 37 is not related to patentability as defined in *Festo*.

**B. 35 U.S.C. § 103**

**1. Klein et al. and Chamberlain et al.**

Claims 9-15, 39 and 42 were rejected under 35 U.S.C § 103 as being obvious in view of Klein et al. and Chamberlain et al. Claims 9-15, 39 and 42 depend directly or indirectly on claim 1 or claim 34. Chamberlain et al. does not solve the deficiencies of Klein et al. in that Chamberlain et al. does not suggest altering Klein et al. so that either 1) web 38 lies upon belt 202 or 2) planar area 202 moving parallel to web 38. Without such suggestion, the rejection is improper and should be withdrawn.

Despite the impropriety of the rejection, claims 9-15, 39 and 42 have been canceled in order to expedite prosecution of the application by having the allowed claims granted in a patent. Accordingly, the cancellation of claims 9-15, 39 and 42 is not related to patentability as defined in *Festo*.

**2. Klein et al. and Barber et al.**

Claims 16-21 were rejected under 35 U.S.C § 103 as being obvious in view of Klein et al. and Barber et al. Claims 16-21 depend directly or indirectly on claim 1. Barber et al. each does not solve the deficiencies of Klein et al. in that Barber et al. does not suggest altering Klein et al. so that Klein et al.'s web 38 lies upon belt 202. Without such suggestion, the rejection is improper and should be withdrawn.

Despite the impropriety of the rejection, claims 16-21 have been canceled in order to expedite prosecution of the application by having the allowed claims granted in a patent. Accordingly, the cancellation of claims 16-21 is not related to patentability as defined in *Festo*.

**C. Claims 22-33, 36, 38, 40, 41, 43-52 and 56-65**

Applicant notes with appreciation that claims 22-33, 36, 38, 40, 41, 43-52 and 56-65 have been allowed.

Applicant notes that a statement of reasons for allowance of the claims is provided.

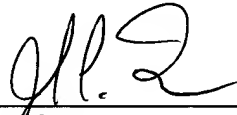
Applicant traverses the statement in that there are broader and/or other reasons why the claims are patentable.

Applicant traverses the statement for the further reason that it recites elements that are not present in one or more of the independent claims, such as 1) a “second applicator”, 2) “means for placing a second label onto the label located on the portion of the web so as to attach the second label to the (prior) label”, 3) “means of controlling the speed while the second label is being pressed onto the label located on the portion of the web” and 4) “means controlling the linear speed of the web along the first direction relative to the linear speed of the planar portion parallel to the first direction so as to diminish the risk that the web becomes skewed during the pressing.”

## CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 22-33, 36, 38, 40, 41, 43-52 and 56-65 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,



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